REMARKS

Claims 1-8 are currently pending in the subject application and are presently under consideration. Claims 9-17 and 20-26 have been withdrawn pursuant to a restriction requirement and are hereby cancelled. Claim 1 has been amended herein, and claims 27-38 have been added. A complete listing of the claims showing changes made in revised amendment format can be found at pages 2-5. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-8 Under U.S.C. §101

Claims 1-8 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The subject claims, as amended, recite statutory subject matter.

Independent claim 1 has been amended to more clearly recite a practical application of the claimed method in the technological arts and thus is directed to statutory subject matter. It is believed the amendment obviates the rejection of independent claim 1 (and claims 2-8 which depend therefrom). Hence, this rejection should be withdrawn.

II. Rejection of Claims 1-8 Under U.S.C. §103(a)

Claims 1-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Case, *et al.* (US 5,734,890). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

Case, *et al.* does not teach or suggest applicant's invention as recited in the subject claims.

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in***

> ***the art, to modify the reference*** or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Independent claim 1 has been amended herein to recite a computer implemented methodology for transacting business over a network, including...***correlating deals*** for at least one of a product and service offered by at least one seller to the price and non-price criteria inputted by a buyer. Case, *et al.* does not teach or suggest ***correlating the deals*** for a product or service by a seller to price and non-price criteria by a buyer to facilitate a listing of deals that match the buying criteria of the buyer. Examiner asserts that Table 1 of Case, *et al.* teaches this limitation. However, Table 1 is not directed toward the ***correlation of deals*** to price and non-price criteria for such deals. Rather, Table 1 is directed toward evaluating a list of decision criteria by employing a survey to document the criteria and attach a weight to each criterion. This survey disclosed in Case, *et al.* provides a listing of factors employed in a procurement ***which has already taken place***. Thus, such a listing of criteria cannot be employed to facilitate a sale of a good or service by providing a listing of a plurality of deals for such a good or service, as recited in the subject claims, since it is utilized after a sale has been consummated.

Furthermore, Case, *et al.* does not teach or suggest a computer-implemented business transaction methodology which ultimately outputs a ***list of deals listed by a seller that match the buying criteria of a buyer***. Instead, Case, *et al.* merely discloses a decision tool utilized to list and rank a plurality of factors employed by ***a single party*** to make a decision. Such a tool cannot provide a list of specific deals that match ***both the requirements of the seller and the buyer***, as recited in the subject claims. For example, such a system ***does not account for the needs of another party*** and further ***does not provide a listing*** of such other party's requirements to the user to help facilitate a

decision. Rather, the decision output by the decision tool is ***based solely on the needs of the user*** and as such ***does not consider the needs of other parties.***

Additionally, the factors listed in the survey as disclosed by Case, *et al.* do not relate to specific deals that meet the requirements of a prospective buyer. Instead, the factors simply point out disparate criterion and their relative importance to the buyer which do not provide the buyer with a list of deals, as recited in the subject claims. For example, a buyer searching for goods or services cannot find a specific deal utilizing Case, *et al.*

Moreover, Case *et al.* does not teach or suggest outputting a list of deals in ***real time*** from amongst the plurality of deals that match the buying criteria of the buyer since such criterion are non-specific and listed in a survey after the sale has been completed. The Examiner states this limitation, although not disclosed in Case *et al.*, is obvious to one of ordinary skill in the art since it would provide common knowledge computer implemented business transactions in a buyer/seller deal matching system. However, it is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. *See Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241.

Furthermore, applicant's representative traverses the Official Notice with respect to claims 2-8 and respectfully requests a showing of a reference pursuant to M.P.E.P. §2144.03 to support the assertion, or in the alternative, withdrawal of this taking of Official Notice from the rejection.

Accordingly, for the aforementioned reasons, it is submitted that Case *et al.* does not make the applicant's invention obvious as recited in claim 1 (or claims 2-8 which depend therefrom) and this rejection should be withdrawn.

III. New Claims 27-38

Claims 27-38 have been newly added herein to emphasize various aspects of the subject invention neither disclosed nor suggested by the cited reference. In view of amended claim 1, applicant's representative respectfully submits that no additional search will be required to examine new claims 27-38 and accordingly requests their entrance and allowance.

CONCLUSION

The present application is believed to be in condition for allowance, in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
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